

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/10/2010 has been entered.

Response to Amendment

Applicant has amended claim 1. Examiner has considered the amendment to the claim very carefully and addressed them below.

Response to Arguments

1. Applicant's arguments filed on 05/10/2010 have been fully considered but they are not persuasive. Examiner respectfully disagrees with the applicant at least for the following:

2. in response to the applicant's argument on " Luciano , clearly illustrate that the initiation of the wheel game is dependent upon the results, ie, the completion of the first game", examiner respectfully disagrees because giving the claims it's broadest reasonable interpretation, it can be stated that Luciano's teachings of second game result or outcome is evaluated independent of the first game outcome. The second

game maybe triggered by the first game outcome or triggering symbol of Luciano, however the outcome of the second game is independently evaluated, in other words outcome of the base game does not guarantee a certain result of the second game, while this outcome influences the outcome of the first game (summary).

3. In response to the applicant's argument on "the second game is not automatically initiated", respectfully applicant has not claimed this limitation positively, a second game triggering after the base game initiation, as claimed on claim 20 reads on Luciano's teachings of base game which generated triggering symbol to initiate second game and the result of the second game alter the base game.

Besides , even if applicant decides to use the word "automatic" initiation of the second game, it is further needs to be clarified by stating that the initiation of the second game is not being triggered by a triggering event or symbol. An initiation of a triggering symbol is indeed automatic.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method recited in this claim includes the judicial exception of an abstract idea (a method of increasing probability of an award feature).

No physical transformation is present to establish a practical application of the abstract idea.

As explained in the Interim Guidelines in view of *In re Bilski*, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purpose of 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent¹ and recent Federal Circuit decision, the Office's guidance to examiners is that a 101 process (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ***This is called "machine-or-transformation test".*** If neither of these is met by the claim, the method is not a patent eligible process under 101 and should be rejected as being non-statutory subject matter.

For example the method steps recited in this claim does not positively tie to a machine, computer or processor. Playing a game on a electronic gaming machine does not positively disclose the steps implementation are being done by the machine, thus the claim language fails to pass "machine-or-transformation test".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. **Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano (US 6, 705, 944) prior publication date Feb 6, 2003.**

Regarding claim 1, Luciano teaches a game machine with base game and bonus game having following limitations:

A gaming machine operable to play a base game and a second game (abstract); gaming machine including a first display adapted to display progress and results of said base game (FIG 1), displays the base game;

gaming machine further including a second display adapted to display progress and results of said second game(FIG 1), also shows the second game or the bonus game display;

base game and said second game arranged to be played such that selected ones of outcomes of said second game affect play of said base game (col 2, lines 54-65), explains the alteration of the base game results,

whilst the outcome of said second game is independent of the outcome of said base game (col 3, lines 1-4), Luciano is silent on disclosing the base game and the second game are initiated substantially simultaneously; the word substantially means near perfect or almost, thus the claim language does not require the base game and the second game to start at the same time; Luciano discloses if the reel spins results in a symbol "spin the wheel" the second game starts (col 8, 18-20), which is not substantially simultaneously, however it can possibly be since the symbol "spin the wheel" can be generated with the first spin of the slot reel; therefore it would have been obvious to ordinary skilled artisan at the time of invention to include the triggering of the game substantially simultaneously to keep the players interested to play the game and to create player anticipation.

Regarding claims 3-4, Luciano teaches various award can be obtained by the base game and the second game such as free spins award, credit award or jackpot award (col 3, lines 2-7,col 10, lines 66-67).

Regarding claims 5-6, Luciano teaches both base and second game to be symbol-driven game (FIG 1 shows the base game with spinning reels and second game with the wheel spinning reels with symbols).

Regarding claims 7-8, Luciano teaches both base game reels and second game wheel is sequentially controlled (col 5, lines 44-48).

Regarding claim 9, Luciano discloses the sequence of progress of second game is interleaved with the sequence of the base game (FIG 2, wheels shows the losing a spin or try again), which means player win nil or lose a spin with nil winning and when the outcome of second game is determined, then the base game starts again.

Regarding claims 10-11, Luciano discloses the wheel comes to a stop to determine the win and further depending on winning such as re-reel spin, initiates the base game reel-spin while wheel stay paused (FIG 2, col 8, lines 5-67), shows how the base game and the second game is played concurrently.

Regarding claim 12, Luciano teaches play of a base game initiate the play of the second game which are played concurrently (col 8, lines 5-45).

Regarding claim 13, Luciano teaches the game a machine includes the array of multiple reels (FIG 1, 3), shows 3 reels.

Regarding claims 14-16, Luciano discloses base game has multiple reels with numbers of sectors displayed, further Luciano teaches second game has a multiple concentric wheels which is an alternative to the reels and designed in similar fashion with various symbols thereon (FIG 2), however Luciano is silent on disclosing an additional reel with an open able aperture. It is evident by the teachings of Luciano such as Wild symbol wheel on FIG 2 which can be considered as an additional reel for the second game. This is an obvious addition to the art of slot machine and merely an alternative to the teaching of Luciano, therefore it would have been obvious to ordinary skilled artisan at the time the invention was made to include an additional hidden symbol to create an additional winning symbol combination to create excitement or simply as an alternative.

Regarding claim 17, Luciano teaches the win is determined according to a predetermined disposition of symbols when the reels reach a stationary state at the end of the second game (col 8, lines 5-55).

Regarding claim 18, In addition to rationale provided above on claims 14-16, Luciano teaches the base game initiate the second game (col 8, lines 18-20), which is the wheel spins game after the starting of the base game.

Regarding claim 19, Luciano teaches initiating the base game and the second game substantially simultaneously in sequence to increase the probability of the winning of the base game by the effect of the second game (col 8, lines 5-65), Luciano discloses how the base game initiate the wheel to spin, which is the second game then the result from the second game cause the reel to re-spin in the base game to alter the result of the base game.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Luciano (US 6, 705, 944) prior publication date Feb 6, 2003.**

Regarding claim 20, Luciano teaches method of increasing probability of an award of a feature game having following limitations:

a) Providing a base game and a second game on an Electronic Gaming Machine together with a first display for displaying progress and results of said base game and a second display for displaying progress and results of said second game (FIG 1, 2 col 2,

lines 67-col3, lines 5);

- b) Causing a play of said second game to be triggered when a play of said base game is initiated (col 8, 18-20), giving the claim its broadest reasonable interpretation, examiner has interpreted this limitation as the second game triggers after the initiation of the base game, thus Luciano clearly teach this limitation as cited;
- c) Allowing selected ones of outcomes of said second game to affect play of said base game whilst the outcome of said second game is maintained independent of the outcome of said base game (col 10, lines 23-27), the second game such as wheel spinning has various outcomes among free spins and multiplier which directly affect the base game, however the wheel spin outcome itself is in independent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 10:00am-7:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Masud Ahmed/
Examiner, Art Unit 3714